



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,129	03/21/2001	Takeshi Nishiuchi	010337	1444

23850 7590 09/24/2002

ARMSTRONG, WESTERMAN & HATTORI, LLP
1725 K STREET, NW.
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

BUEKER, RICHARD R

ART UNIT	PAPER NUMBER
----------	--------------

1763

DATE MAILED: 09/24/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,129

Applicant(s)

NISHIUCHI ET AL.

Examiner

Richard Bueker

Art Unit

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

Art Unit: 1763

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to an apparatus, classified in class 118, subclass 716.
- II. Claims 7-8, drawn to a process, classified in class 427, subclass 250.

Claim 6 link(s) inventions I and II. The restriction requirement of the linked inventions is subject to the nonallowance of the linking claim(s), claim 6. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP §

Application/Control Number: 09/813,129

Art Unit: 1763

806.05(e)). In this case the apparatus can be used to deposit a coating on articles other than rare earth metal-based magnets.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Stephen G. Adrian on August 28, 2001 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 4, line 10, "said accommodating section" lacks proper antecedent basis because the claim previously defined plural accommodating sections. In claim 5, line 2, "radiately" is non-idiomatic and indefinite, and in claim 5, line 3, "a rotational axis" is indefinite because it is unclear if it refers to the rotational axis defined in claim 4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1763

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (JP 07-070738) taken in view of Steube (4,116,161) , Baer (3,517,644) or applicants' description of the prior art. Yamada (Figs. 1 and 7-10) discloses a vacuum evaporation apparatus having a tubular rotatable barrel and an evaporation source mounted in a vacuum chamber. The barrel is supported circumferentially outside a horizontal rotational axis of a rotatable support member, so that the distance between the barrel and the evaporation source can be varied by rotating the support member as claimed. Steube (Fig. 2), Baer (Figs. 1-5) and applicants' description of the prior art (Fig. 9) are cited to more clearly illustrate the positioning of a tubular rotatable barrel with respect to an evaporation source in a conventional prior art vacuum evaporation apparatus. It would have been at least obvious to one skilled in the art to provide the vacuum evaporation source of Yamada in a position below the rotatable barrels, in the manner shown in Steube, Baer and applicants' description of the prior art.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (JP 07-070738) taken in view of Steube (4,116,161) , Baer (3,517,644) or applicants' description of the prior art as stated above, and in further view of Humphrey (5,201,956) and/or Yira (6,326,056). Humphrey (see Fig. 1) and Yira (see Figs. 2-6 and col. 6, lines 3-6) disclose screen barrels for vapor coating small articles. They teach that the screen container can be subdivided into plural subsections for holding more articles to be coated. Yira teaches (col. 6, lines 38-48) that this type of screen barrel can be used for other types of coatings on other types of articles or work pieces that

Application/Control Number: 09/813,129

Art Unit: 1763

require tumbling or mechanical agitation during coating. It would have been obvious to one skilled in the art to use a subdivided screen barrel of the type taught by Humphrey and/or Yira in the apparatus of Yamada because Humphrey and Yira teach that a subdivided screen barrel will allow more articles to be coated when used in a vapor coating process that requires tumbling or mechanical agitation, such as in Yamada's coating process.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer (3,517,644) Humphrey (5,201,956) and/or Yira (6,326,056). Baer discloses a vacuum evaporation apparatus comprising a vacuum evaporation source and a tubular rotatable barrel. The barrel is not subdivided as recited in claims 4-5. Humphrey (see Fig. 1) and Yira (see Figs. 2-6 and col. 6, lines 3-6) disclose screen barrels for vapor coating small articles. They teach that the screen container can be subdivided into plural subsections for holding more articles to be coated. Yira teaches (col. 6, lines 38-48) that this type of screen barrel can be used for other types of coatings on other types of articles or work pieces that require tumbling or mechanical agitation during coating. It would have been obvious to one skilled in the art to use a subdivided screen barrel of the type taught by Humphrey and/or Yira in the apparatus of Baer because Humphrey and Yira teach that a subdivided screen barrel will allow more articles to be coated when used in a vapor coating process that requires tumbling or mechanical agitation, such as in Baer's coating process.

Claims 4-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DDR patent document DD 244993,

Art Unit: 1763

which discloses (see Figs. 1-2) a vacuum evaporation coating apparatus having a vacuum evaporation source and a rotatable barrel inside a vacuum chamber. The rotating barrel is divided into plural sections that inherently can accommodate the small articles that are to be coated.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fujita (JP 57-188677) illustrates a subdivided rotatable barrel analogous to that of DD 244993, except that Fujita's axis of rotation is not horizontal as in DD 244993..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Bueker whose telephone number is (703) 308-1895. The examiner can normally be reached on 9 AM - 5:30 PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on (703) 308-1633. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Richard Bueker
Richard Bueker
Primary Examiner
Art Unit 1763

September 23, 2002